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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,018	01/16/2004	Jean-Bruno Danezin	P24744	5754
7055 7590 09/19/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER PATTERSON, MARIE D	
			ART UNIT 3728	PAPER NUMBER
			NOTIFICATION DATE 09/19/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/758,018

Applicant(s)

DANEZIN ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-18 and 20-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-18, and 20-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Specification

1. The amendment filed 7/25/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: there is no basis in the original specification for limiting the insert to being the only insert as now added in paragraph [0012].

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. Claims 11, 13, 15, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 11, 13, 15, and 18 the phrase "provides an abrasive anti-slip feature for the inner sole only upon a certain downward pressure being exerted on the inner sole" is confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. There is no guidance in the specification as to what such language would encompass and the sand paper disclosed is not considered to have such a property.

3. Claims 29, 32, and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention. there is no basis in the original specification for limiting the insert to being the "only" insert.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-6, 11-13, 18, 20, 21, 22, 25, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardt (2003/0150134) in view of Harrison (6055748).

Hardt shows an inner sole made of flexible material (50 and 52, figure 5) with an abrasive lower surface (see paragraph [0027]) substantially as claimed except for the exact means for providing the abrasive lower surface. Harrison teaches the use of a paper material with abrasive materials adhered to one side and adhesive on the other for attachment to items where a sandpaper antislip surface is desired. It would have been obvious to provide the sandpaper antislip surface by using a paper material as taught by Harrison in the inner sole of Hardt to allow a user to easily adjust the location and/or amount of antislip surface desired on the inner sole.

6. Claims 2 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polifroni in view of Hardt (2003/0150134) and Harrison (6055748).

Polifroni shows an innersole (10) with recesses (42 and 44) for anti-slip inserts (48 and 49) and teaches the use of "any suitable slip resistant material" (column 4 line 50)

for the inserts. Hardt teaches the use of a rough surface similar to sandpaper for the antislip surface in innersoles (see paragraph [0027]. Harrison teaches providing sandpaper type antislip surfaces by providing a paper substrate with adhesive and a coating of abrasive amalgam. It would have been obvious to make the bottom surfaces of the inserts with an abrasive sandpaper-like surface as taught by Hardt and to provide such a surface by providing a sheet of abrasive paper as taught by Harrison in the innersole of Polifroni to provide an antislip surface that may be replaced, altered to adjust the degree of antislip, abrasion, etc..

In reference to claim 29, it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

7. Claims 7, 10, 15-17, 23, 24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonaventure (5228218) in view of Hardt and Harrison.

Bonaventure shows a ski boot which is conventionally made from rigid plastics (2), a removable liner (11) with a removable innersole (14) substantially as claimed except for antislip insert between the innersole and liner. Hardt teaches providing an antislip abrasive surface on the lower surface of an innersole. Harrison teaches providing sandpaper-like antislip by providing a paper substrate with abrasive material thereon and adhesively attaching the paper to an article. It would have been obvious to provide a sandpaper-like surface on the lower surface of the innersole as taught by Hardt and to use a paper with abrasive material thereon and adhesive for attaching as taught by

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Harrison on the innersole of Bonaventure to prevent the innersole from slipping during wear.

8. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 7 and 10 above, and further in view of Marega (4920666).

Bonaventure as modified above shows a boot substantially as claimed except for providing an outersole on the liner. Marega teaches providing an outersole (33) on a removable liner. It would have been obvious to provide an outersole on the liner as taught by Marega in the boot of Bonaventure as modified above to prevent slipping of the innerboot, increase the durability of the innerboot, etc..

9. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 7 and 10 above, and further in view of Polifroni.

Bonaventure as modified above shows a boot substantially as claimed except for the insole having a recess in a lower felt layer for the antislip material. Polifroni teaches providing a recess in the bottom of an insole for receiving antislip insert material.

Official notice is taken that the use of felt for insoles is well known and conventional. It would have been obvious to use felt as is well known and to provide a recess as taught by Polifroni for the antislip material in the boot of Bonaventure as modified above to prevent the antislip material from moving out of place.

10. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 8 and 9 above, and further in view of Polifroni.

Bonaventure as modified above shows a boot substantially as claimed except for the insole having a recess in a lower felt layer for the antislip material. Polifroni teaches providing a recess in the bottom of an insole for receiving antislip insert material. Official notice is taken that the use of felt for insoles is well known and conventional. It would have been obvious to use felt as is well known and to provide a recess as taught by Polifroni for the antislip material in the boot of Bonaventure as modified above to prevent the antislip material from moving out of place.

In reference to claim 35, it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Response to Arguments

11. Applicant's arguments filed 7/25/07 have been fully considered but they are not persuasive.

Applicant's arguments filed 7/25 /07 have been fully considered but they are not persuasive. In response to applicants arguments directed towards the 112 rejections. It is not clear what structural limitations/materials applicant intends to encompass with such language. It appears that rubber materials, sandpaper, merely a piece of fabric with a large weave would read on such language, i.e. this language appears to read on almost all antislip materials.

In response to applicants' arguments directed towards the boot shell being rigid plastic, the liner being removable and the insole being placed above the liner, all of

these limitations are clearly shown and described in Bonaventure as noted in the above rejections.

In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. In *re Keller*, 208 USPQ 871 (CCPA 1981). For example the reference to Harrson has been applied as a teaching of how to provide an abrasive substance to a shoe/boot element and not applied or intended to show or teach the location of the abrasive substance.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In *re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571)273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson
Primary Examiner
Art Unit 3728